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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* MARGARET GARDNER MACPHAIL

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Appeal 2009-004491  
Application 10/042,107  
Technology Center 2100

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Decided: May 10, 2010

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Before JOHN A. JEFFERY, JAMES D. THOMAS, and DEBRA K. STEPHENS, *Administrative Patent Judges*.

THOMAS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-36. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

*Invention*

The present invention addresses the problem of optimizing data stored in a database so that it may be easily and conveniently used for the limited size i.e. small display interfaces of PDAs, personal palm devices and cellular telephones. Simply stated, the present invention addresses this problem by providing a database wherein a plurality of different types of data are in turn further each represented by a plurality of strings of sequential segments. Each segment of each of said plurality of strings of each of said different types of data has a content which fits the device display size. When a particular data type is selected by a user at a display station, then in turn, the string stored in the database, the segments of which fit the dimensions of the limited display is provided from the database, and the segments in the string are sequentially displayed.

(App. Br. 3; Figs. 1, 3, 7, 8.)

*Representative Claim*

1. A computer controlled database system for providing a user with database output through a user interface having predefined dimensions limiting the capacity of each iterative segment of output comprising:

    a database for storing a plurality of different types of output data including:

        means for storing in said database data segments for each of the different types of stored data, each segment having a capacity limited by said predefined dimensions of said user interface; and

        means for storing in said database a plurality of strings of said segments, each string including a sequence of segments of one different type of stored data;

        means enabling a user to select one of said strings of segments to be output; and

        means for outputting said selected string of segments at said user interface.

*Prior Art and Examiner's Rejections*

The Examiner relies on the following references as evidence of unpatentability:

Guck	US 5,864,870	Jan. 26, 1999
Benschoter	US 2003/0101230 A1	May 29, 2003 (filed Nov. 26, 2001)
Shin	US 6,674,439 B1	Jan. 6, 2004 (filed May 8, 2000)

Claims 1-36, all claims on appeal, stand rejected under 35 U.S.C. § 103. In a first stated rejection as to claims 1-3, 8-11, 13-15, 20-23, 25-27, and 32-35, the Examiner relies upon Shin alone. In a second stated rejection, the Examiner relies upon Guck in addition to Shin as to claims 4-7, 12, 16-19, 24, 28-31, and 36. Lastly, in a third stated rejection as to claims 12, 24, and 36, the Examiner adds Benschoter to the combination of Shin and Guck.

*Claim Groupings*

Based upon Appellant's arguments in the principal Brief on appeal, independent claim 1 is considered representative of the subject matter of independent claims 1, 13, and 25 on appeal as well as their respective dependent claims within the first stated rejection. Similarly, as to the second stated rejection, Appellant considers dependent claim 4 as representative of the subject matter of all claims within this rejection. Lastly, as to the third stated rejection, Appellant relies for patentability upon the previously stated arguments.

## ISSUE

Did the Examiner err in finding that Shin teaches a plurality of strings of sequential data elements, each string having a plurality of segments, where each segment has a capacity limited by predefined dimensions of a user interface, as recited in representative independent claim 1 on appeal?

## FINDINGS OF FACT (“FF”)

Shin’s Abstract is reproduced here:

A mobile terminal is provided which can obtain an image from a server and change the size of the image so as to use the image as a background image. An image obtaining unit obtains an image from a server. An over-size decision unit decides whether the entirety of the image obtained by the image obtaining unit can be displayed within the display area in a screen. When the over-size decision unit provides a negative decision, an image resizing unit changes the size of the image obtained by the image obtaining unit so that it can be displayed within the display area in the screen.

The mobile terminals 10, 11 in Figure 1 operate in an environment corresponding to Appellants’ disclosed invention. One of these terminals is illustrated in a functional structure in Figure 4 as relied upon by Examiner. This is the first embodiment of Shin’s inventive contributions. The Examiner appears to argue that the claimed database is the accumulative image storage unit 408 in Figure 4. Comparable capacities of the graphical interface or screen of these terminals are illustrated in Figure 5 to compare the ability of the given display element in a terminal device to display a certain area as well as the requirements of the data to be displayed. The logic of how this

is accommodated is shown in Figure 6 with examples in Figures 7 through 9. Of equal significance is the showing of a second embodiment beginning in Figure 10, which appears to focus upon accommodating HTML message data in various storage units and the logic of processing in Figure 12 the type of HTML element information stored. Thus, Shin clearly teaches the ability to store different types of information, which features are emphasized in the paragraph bridging columns 21 and 22 with respect to the Figure 13 showing in Shin as relied upon by the Examiner.

## ANALYSIS

We refer to, rely on, and adopt the Examiner's findings and conclusions set forth in the Answer. Our discussions will be limited to the following points of emphasis.

At pages 9 and 10 of the principal Brief and at pages 2 and 4 of the Reply Brief, Appellant improperly argues that each segment of each of the plurality of strings of each of the different types of data has a content which fits the device display size. This argument is not coextensive with and does not repeat what is actually claimed in representative claim 1 on appeal. Actually, there is a much broader recitation where each segment has its capacity limited by the predetermined dimensions of the user interface recited. The Examiner's findings in addition to our separate findings as to Shin in this opinion clearly justify the Examiner's conclusion that Shin teaches the subject matter of representative independent claim 1 on appeal argued not to be present in this reference.

Additionally, Appellant's positions with respect to the storage size of the cellular telephones in Shin being severely limited at pages 9 and 10 of

the principal Brief, and repeated in the Reply Brief, is equally unavailing of patentability since storage capacity of the claimed database is recited so broadly as to be inclusive within the teachings of Shin.

The positions set forth in the principal Brief on appeal do not address the Examiner's reasoning in the Final Rejection directed at the non-functional descriptive material recited, for example, within representative independent claim 1 on appeal. The Examiner repeats these positions in the Answer. In recognizing at page 4 of the Reply Brief that the claims expressly and completely include what the Examiner has characterized as nonfunctional descriptive material, Appellant appears to admit that the Examiner's position is correct since the positions taken there do not argue before us that the Examiner's positions as to this characterization are incorrect. Appellant goes on to continue to assert this non-functional descriptive material is the predicate of patentability for the subject matter of representative independent claim 1 on appeal. We find this position unpersuasive.

Next, we turn to the second and third state of rejections of certain dependent claims rejected under 35 U.S.C. § 103 relying upon at least two references. Appellant's arguments beginning at page 12 of the principal Brief on appeal do not argue that the Examiner-relied-upon additional prior art references are not properly combinable within 35 U.S.C. § 103.

Appellant does not deny that Guck teaches database files having the same type of data (i.e., image data) claimed, and appears to argue at the top of page 13 of this Brief the same arguments presented with respect to the initial rejection of representative independent claim 1 on appeal within the first stated rejection under 35 U.S.C. § 103 over Shin alone. Moreover, as to

the features of dependent claim 4 reciting that a type of data includes image data, not only does Guck expressly teach storing that particular type of data, but also the Examiner and our findings of fact in this opinion have indicated that Shin already teaches this feature. Therefore, Guck is considered to be cumulative as to this argued feature. As to features of dependent claim 12 rejected within the third stated rejection, Appellant's position at the top of 14 of the principal Brief on appeal appears to concede that Benschoter teaches the ability to change the order of segments to be displayed. The broadly recited changing capabilities are reflective of the modifying capability within the disclosed invention, a feature also taught within the teachings we noted in our findings of fact with respect to Shin.

#### CONCLUSION AND DECISION

Appellant has not shown that the Examiner has erred in finding that Shin teaches the ability to store different types of data having different characteristics associated with them as applied to a particular user interface as recited in representative independent claim 1 on appeal. Correspondingly, Appellant has not shown that the Examiner has erred in the application of additional prior art within 35 U.S.C. § 103. Therefore, we affirm the Examiner's three stated rejections of all claims on appeal, claims 1-36, rejected under 35 U.S.C. § 103. All claims on appeal are unpatentable.

Appeal 2009-004491  
Application 10/042,107

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

**AFFIRMED**

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